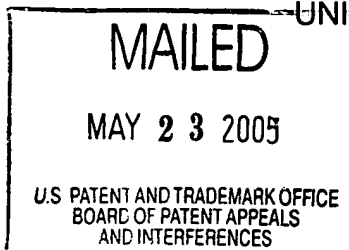


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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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AUG 8 - 2005

**Ex parte** SHERRY A. COOK, JOSEPH W. LUCIANO,  
JOHN A. MOORE, BRANDON L. SATANEK  
and JAMES A. WARD

DIRECTOR OFFICE  
TECHNOLOGY CENTER 2000

Appeal No. 2005-0357  
Application No. 09/610,081

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-4 and 6-22, which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

Appellants' invention relates to a printer apparatus with an integrated graphical user interface and method for using the same. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium, said printing apparatus comprising:

an input member for receiving said one or more digital photographs from a source;

an image processor for generating an image corresponding to each digital photograph;

an integrated graphical user interface with a video display for displaying said images and for selecting one or more of said digital photographs for a printed page;

at least one drive for receiving a computer readable medium, wherein said source is a computer readable medium disposed in said drive; and

a print control for producing on said printable medium a pattern associated with said printed page.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Levine	4,751,583	Jun. 14, 1988
Matsumoto et al. (Matsumoto)	5,796,428	Aug. 18, 1998
McCann et al. (McCann)	5,963,939	Oct. 5, 1999

Claims 1-4, 6-9, 11-13, 15, 16, and 18-22 stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by Levine. Claims 10 and 14 stand rejected under

35 U.S.C. § 103(a) as being unpatentable over Levine in view of McCann. Claim 17

stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine in view of Matsumoto.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Jan. 28, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed Nov. 5, 2003) for appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

### 35 U.S.C. § 102

Initially, we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. U.S. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358,

1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. With respect to independent claim 1, we note that the preamble sets forth a "stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium." Appellants have defined the term "photoprinter" in the specification to be a stand-alone appliance, but appellants have not specifically defined a "printing apparatus." Therefore, giving the term its broadest interpretation, we find that a "printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium" can be interpreted broadly to be an apparatus which is used in the manipulation of print data which will be used in the production of an image on a printable medium, i.e., "for transferring" is interpreted as a statement of intended use of the "printing apparatus" and the "printing apparatus" can be a computer which prepares photographs for delivery to a printer. Here, appellants have elected to use terminology

different from that specifically defined in the specification. Therefore, we find this to be broader than a "photoprinter" as defined in the specification.

The examiner maintains that Levine teaches the invention as recited in independent claim 1. (Answer at pages 4-5.) Levine teaches an integrated screen 13 with GUI with the previewer and processor 12 and keyboard 14 with internal image selection and processing circuitry which is modularly detachably interconnected with copier printer 22. Levine further teaches a connector 19 to receive inputs from a camera. Levine further teaches that the system has internal memory which would have been a drive as defined by appellants. Additionally, we find that the output of the previewer of Levine would have been an output with control functionality which would teach the intended use of a "print control for producing on said printable medium a pattern associated with said printed page," as recited in independent claim 1. (Levine at columns 2-3 and 6-7 and Figures 1 and 3.) Therefore, we find that Levine teaches the invention as recited in independent claim 1.

Appellants argue that Levine fails to teach a printing apparatus that is both capable of printing digital files independent of an external host device and has an integrated GUI for selecting one or more digital photographs for a printed page. Appellants argue that Levine further lacks any teaching or suggestion of a GUI for a stand-alone photoprinter as recited in independent claim 12 and Levine lacks any teaching of a method for previewing and printing photographs on a stand-alone photoprinter as claimed in independent claim 18. (Brief at pages 9 and 10.) We agree

with appellants with respect to independent claims 12 and 18, but do not agree with respect to independent claim 1.

Appellants argue that as defined by the present application and agreed to by the examiner, a "stand-alone" printing apparatus is an apparatus that is capable of, *inter alia*, processing and printing digital files independent of an external host device, such as a computer." (Brief at page 10.) We do not agree with appellants' interpretation of the instant claim language, and we do not find it appropriate to read the definition of "stand-alone" into the language of independent claim 1 since the term is specifically defined as it relates to a "[photo]printer" and not a "printing apparatus." We find a "printing apparatus" to be broader than a "printer" or "photoprinter" and we do not find appellants' arguments with respect to "stand-alone" to be controlling. (Brief at pages 10-12.) Therefore, this argument is not persuasive with respect to independent claim 1, and we will sustain the rejection of independent claim 1.

Since appellants have elected to group dependent claims 2-4, 6-8 and 11 with independent claim 1, we will sustain the rejection of these claims with independent claim 1.

We reach a different result with respect to independent claims 12 and 18. While these claims do not recite a printer which affixes an image to a medium in the body of the claim, we find that the preambles recite a "stand-alone photoprinter" as defined in the specification at pages 7-8. We cannot find that the modular system of Levine teaches the singular stand-alone appliance as recited in the language of independent

claims 12 and 18, when properly interpreted in light of the express definitions in the specification. Therefore, we cannot sustain the rejection of independent claims 12 and 18 as anticipated by the teachings of Levine alone. With respect to independent claims 12 and 18, we find appellants' arguments with respect to a "stand-alone" photoprinter to be persuasive since we do not find the modular system of Levine to meet the recited limitations. (Brief at page 12-16.) Therefore, the teachings of Levine do not anticipate independent claims 12 and 18, and we cannot sustain the rejection of independent claims 12 and 18.

The examiner maintains that Levine teaches every element of the claimed invention. (Answer at pages 6-9.) Appellants argue that the specification at pages 5 and 6 define a photoprinter as a "stand-alone appliance for printing digital photographs onto a printable medium" and that the term "stand-alone" means that the printer "is capable of processing and printing digital files independent of external host device, such as a computer," and the term "processing" means "calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file." (Specification at pages 7-8.) We find this to be a specific definition of the claimed "photoprinter" which the examiner is required to consider when interpreting the claimed invention.

The examiner in the Response to Argument section refers to the copier-printer connected to the processor-preview unit as independent of an external host computer and the examiner uses the frame of reference of "when" the previewer "is connected to" the printer there is no external host computer. (Answer at pages 13-16.) This

interpretation flies in the face of the specific definition recited in the specification, and we find the examiner's application of the teachings of Levine to be unreasonable when the claims are properly interpreted in light of the express definitions in the specification. Therefore, we cannot sustain the rejection of independent claims 12 and 18 and their dependent claims.

While we find the teachings of Levine do not anticipate the claimed invention, we find no alternative analysis of these teachings under 35 U.S.C. § 103. The examiner has made no findings or conclusions regarding the obviousness of combining these functional units into a single stand-alone appliance/photoprinter, nor has the examiner applied a reference which would have suggested combining these functional units in the same housing. Therefore, we make no findings relative to the obviousness of the invention recited in independent claims 12 and 18.

With respect to dependent claim 9, appellants argue that Levine does not teach activation of a print button in the image view in which the image is depicted on the video display. (Brief at pages 16-17.) The examiner maintains that the keyboard has keys or buttons that would be used by the user to enter the request to print. (Answer at page 17.) We disagree with the examiner and the support proffered thereto, and we do not find that Levine expressly teaches a button in the GUI for this function. Therefore, the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of dependent claim 9.



**35 U.S.C. § 103**

With respect to dependent claim 10, appellants argue that the combination of Levine and McCann does not teach or suggest the invention as recited in dependent claim 10 and that there is no motivation for the combination of the value-added reseller application tool of McCann with the portable electronic still camera and image processing system of Levine. (Brief at pages 17-21.) We agree with appellants that the examiner has not established a *prima facie* case of obviousness and has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to look to the teachings of McCann which are completely unrelated to the still camera printing and the GUI thereto. Therefore, we cannot sustain the rejection of dependent claim 10 and dependent claim 14 which depends on independent claim 12 whose rejection was reversed.

With respect to dependent claim 17, dependent claim 17 depends on independent claim 12 whose rejection was reversed. The examiner has not identified how the teaching of Matsumoto remedies the deficiency in Levine alone. Therefore, we cannot sustain the rejection of dependent claim 17.

**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-4, 6-8 and 11 under 35 U.S.C. § 102 is affirmed, the decision of the examiner to reject claims 9, 12,

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13, 15, 16, and 18-22 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 10, 14, and 17 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

**AFFIRMED-IN-PART**

*Lee E. Barrett*  
LEE E. BARRETT  
Administrative Patent Judge

*Joseph F. Ruggiero*  
JOSEPH F. RUGGIERO  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

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Appeal No. 2005-0357  
Application No. 09/610,081

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